

REMARKS

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

I. Advisory Action

In the Advisory Action of July 24, 2009, the Examiner denied entry of the amendments in the After Final Amendment of June 19, 2009 on grounds that they raise new issues requiring further consideration and/or search.

In reply, Applicants herein submit an RCE to gain entry of the after final amendments pursuant to the provisions of 37 C.F.R. § 1.114. . The arguments set forth in the After Final Amendment are reiterated herein by reference as they apply to the claims as amended by way of the present amendment.

Based on the comments in item 11 of the Advisory Action, the Examiner appears to talking about the new proviso clause in claims 3 and 11. Yet, the Examiner's position with respect to the new matter rejection of claim 3 is unclear. It is unclear from the comments whether: (1) the new proviso clause in claims 3 and 11, if entered, would overcome the new matter rejection of claim 3, but possibly raises new issues and is thus the basis for its non-entry; or (2) the Examiner considers the new proviso clause to be new matter.

Further, it appears that the Examiner now takes the position that the enablement rejection would be maintained, because the Rule 132 Declaration is good enough for cancer, but not all disorders. This appears to be a new ground of rejection, because the current enablement rejection as set forth in the final Office Action mentions nothing with respect to limiting the claims to cancer.

The Examiner also argues that the 102(b) prior art rejection will be maintained, if the new matter rejection is withdrawn. However, there is no prior art rejection currently applied against the claims. Perhaps, the Examiner meant to say it would be reinstated.

The Examiner indicated that claim 18 is allowed and claims 2, 4-7, 9, 10, 19 and 20 are only objected to, but are otherwise indicated as being directed to allowable subject matter.

II. Claim Status and Amendments

The positions set forth in the Advisory Action are traversed. Nonetheless, for the sole purpose of expediting prosecution and not to acquiesce to the Examiner's positions, Applicants have amended the claims in manner believed to fully address these concerns by incorporating the subject matter indicated as allowable.

To start, the claims have been amended in a manner to incorporate the allowable subject matter and to better conform to US claim form and practice. For instance, claim 1 is amended to specify that the disorder is cancer and to incorporate subject matter of claim 2 (now cancelled). Claims 1 and 11 are amended to comprising format and to better conform to US claim form and practice. Claims 4-6 are amended to incorporate subject matter of claim 3 (now cancelled). Claims 10 and 15 are amended to better conform to US practice for antecedent basis. Claims 12 and 14 are amended to better conform to US practice with respect to antecedent basis. Claim 16 is amended to specify that the disorder is cancer. Support for the two additional compounds added to claim 18 can be found in the disclosure, in the published application at page 15, left column, top compound and bottom compound, respectively having IC50 values from the WST-1 assay of 14 microM and 20 microM. Claim 20 is amended to incorporate subject matter from claim 3.

New claims 21-26 have been added. New claims 21 and 22 depend on claims 18 and 20, respectively, and find support in the claims to which they depend and throughout the general disclosure and corresponding claim 5. New claims 23 and 24 depend on claims 18 and 20, respectively, and find support in the claims to which they depend and throughout the general disclosure and corresponding claims 1 and 11. New claims 25

and 26 depend on claims 18 and 20, respectively, and find support in the claims to which they depend and throughout the general disclosure and corresponding claims 1 and 11

Claim 2-3 and 17 have been cancelled without prejudice or disclaimer thereto. Applicants reserve the right to file a continuation or divisional on any cancelled subject matter.

Claims 1, 4-7, 9-12, and 14-2-26 are pending upon entry of this amendment.

It is believed that the amended claims define patentable subject matter warranting their allowance for the reasons discussed herein.

III. Conclusion

Having addressed all the outstanding issues, the amendment is believed to be fully responsive to the Office Action. It is respectfully submitted that the claims are in condition for allowance and favorable action thereon is requested.


If the Examiner believes that further changes are needed to allow the claims, then please contact the undersigned attorney as Applicants would be willing to discuss proposals to obtain the noted allowable subject matter.

Appln. No. 10/590,054
Amendment dated August 21, 2009
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Respectfully submitted,

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